

## REMARKS

### **I. Background**

The present Amendment is in response to the Examiner's Office Action mailed May 2, 2007. Claims 17, 20, and 36 have been amended and claims 37-49 have been added.<sup>1</sup> Accordingly, claims 17-22 and 36-49 are presented for the Examiner's consideration in light of the following remarks.<sup>2</sup>

### **II. Rejections on the Merits**

#### **A. Rejections under 35 U.S.C. § 102(b)**

Claims 17-20 and 36 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Spence et al.* (U.S. Patent No. 6,488,692).<sup>3</sup> Applicants respectfully traverse.

The Office Action asserts that "the device disclosed by *Spence* is disclosed as malleable, it can be moved between [a planar configuration and a configuration that is transverse to the planar configuration]" (Office Action, page 2). In support of this assertion, the Office Action cited the following portion of *Spence*:

...Ring MR is **malleable** and **has little material memory** which permits it to be deformed from the oval configuration shown in FIG. 7 with a short axis MSA being a fraction of long axis MLA into a more circular configuration in which the short axis is a significant percentage of the long axis, and **to then retain that shape until-mechanically** [sic] **deformed** again back toward the FIG. 7 configuration...

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<sup>1</sup> Support for the claim amendments and new claims can be found throughout the specification.

<sup>2</sup> Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

<sup>3</sup> Although the prior art status of the cited art in this and the remaining rejections is not being challenged at this time, Applicant reserves the right to challenge the prior art status of the cited art at any appropriate time, should the need arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

(*Spence*, col. 8, lines 16-23). Therefore, *Spence* discloses a malleable ring with "little material memory" that "retain[s its] shape until mechanically[ ]deformed." However, claims 17, 20, and 36 recite that "the body [is] **resiliently deformable** from a substantially planar configuration ... towards a transverse configuration." A **malleable** ring with "**little material memory**" that "**retain[s its] shape until mechanically[ ]deformed**" is not the same as a "**resiliently deformable**" body, as recited in claims 17, 20, and 36. Consequently, *Spence* does not disclose each and every limitation of claims 17, 20, and 36. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 17-20 and 36 under Section 102.

Claims 18-19 depend either directly or indirectly from claim 17. Therefore, Applicants respectfully request that the rejection of claims 18-19 be withdrawn for at least the same reasons provided above.

#### **B. Rejections under 35 U.S.C. § 103(a)**

Claims 21 and 22 were rejected as being unpatentable over *Spence* in further in view of *Gifford, et al.* (U.S. Patent No. 5,904,697). Applicants respectfully traverse.

As shown above, *Spence* fails to disclose a "body [that is] resiliently deformable from a substantially planar configuration ... towards a transverse configuration," as recited in claim 20. Applicants respectfully submit that the Office Action has not cited, nor can Applicants find, any portion of *Spence* that teaches or suggests this limitation.

Furthermore, *Spence* teaches away from the use of a "body [that is] resiliently deformable," as recited in claim 20. The M.P.E.P. states that "[i]t is improper to combine references where the references teach away from their combination" (M.P.E.P. § 2145)(*citing In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)). The Federal Circuit has held that "[a] reference may be said to teach away when a person of ordinary skill, upon reading

the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant" (*In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006))(quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)). The M.P.E.P. further states that "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose," then the prior art teaches away from the combination (M.P.E.P. § 2143.01)(citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

*Spence* teaches generally that the intended purpose of the malleable ring is to maintain a vessel incision in an open configuration for the duration of a procedure without use of an external force, such as retractors, and to generally maintain the vessel incision in a closed configuration following the procedure. This intended purpose is generally accomplished by the use of a **malleable** ring in comparison to a **resilient** ring. For example, *Spence* discloses that the malleable ring MR is "manipulated to open the ring" such that "the edges of the vessel are **formed into a shape** which allows entry and exit into the aorta **which would otherwise have to be maintained with retractors**" (*Spence*, col. 9, lines 54-57 and col. 11, lines 23-26). In addition, after being deformed into an open configuration, the malleable ring "retain[s] that shape until mechanically[ ]deformed" (*Id.* at col. 8, lines 22-23). Furthermore, the closure sutures 42 "serve[] to **deform and move the sides of the ring MR toward each other**" to "provide rapid closure of the incision" (*Id.* at col. 10, lines 8-9 and 17-18). Therefore, the malleable ring disclosed by *Spence* generally is deformed into "a shape which allows entry and exit into the aorta" that "retain[s] that shape until mechanically[ ]deformed" back to its original shape rather than being "resiliently movable," as recited by claim 20.

If the malleable ring MR were "resilient[]" rather than malleable, the ring would not maintain its open and closed configuration without an external force. Therefore, even if *Gifford*, or any other reference, did disclose the use of a "body [that is] resiliently deformable," as recited in claim 20, *Spence* would not be combinable with that reference because the intended purpose of the malleable ring in *Spence* is to mechanically deform the ring into an open configuration and "retain[] that shape until mechanically[] deformed" back into a closed configuration. Therefore, the use of any material that is "resiliently movable," as recited in claim 20, would destroy the intended purpose of *Spence* thereby discouraging one of skill in the art from the proposed combination.

Consequently, Applicants respectfully submit that the Office Action has not presented a *prima facie* case of obviousness against claim 20. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 21 and 22 under Section 103.

**C. New claims 37-49**

As shown above, the Office Action has failed to establish either a *prima facie* case of anticipation or a *prima facie* case of obviousness against claims 17, 20, and 36. Specifically, *Spence* fails to disclose, teach, or suggest a "body [that is] resiliently deformable from a substantially planar configuration ... towards a transverse configuration," as recited in claims 17, 20, and 36. Furthermore, *Spence* discourages one of skill in the art from a combination with any reference that may disclose the use of a "body [that is] resiliently deformable," as recited in claims 17, 20, and 36.

New claims 37-44 depend either directly or indirectly from claim 17. New claims 45-47 depend either directly or indirectly from claim 20. New claims 48-49 depend either directly or indirectly from claim 36. Because the Office Action has failed to establish either a *prima facie*

case of anticipation or a *prima facie* case of obviousness against claims 17, 20, and 36, Applicants respectfully submit that claims 37-49 are also allowable.

### **III. Summary and Conclusion**

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 2<sup>nd</sup> day of August, 2007.

Respectfully submitted,

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